

Docket No.: 05525-00003-US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Paul H. Morrill, Jr.

Application No.: 10/757,724

Confirmation No.: 4582

Filed: January 15, 2004

Art Unit: 3693

For: WIRELESS TELEPHONY FOR COLLECTING
TOLLS, CONDUCTING FINANCIAL
TRANSACTIONS, AND AUTHORIZING
OTHER ACTIVITIES

Examiner: J. Patel

DECLARATION UNDER 37 C.F.R. § 1.132

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The undersigned, Paul Morrill, makes this declaration in response to the Office Action of Aug. 12, 2009.

1. In that Action the claims were rejected as "failing to comply with the written description requirement" with respect to the claim recitation of:

"transmitting the selected function code, without further addressing, ..."

2. The Action alleged that this subject matter "was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

3. For the reasons specified below I believe the specification clearly conveys to those skilled in the art that the disputed subject matter was within my possession as of the time the application was filed.

4. The drawings and specification describe the steps which comprise several embodiments of the invention. In one of the steps which are described, a user performs a step of "entering a function code on the keypad of a cellular phone or other wireless communication device, and sending the function code to the central processing unit [of the communication service provider]." (1:34-36¹) The specification states, "Communication takes place between the cellular phone and the mobile telephone service provider's cell antenna and thence via land line to a CPU." (2:29-31)

5. Several embodiments of the invention are illustrated Figs 1A through 1E, figs 2A through 2B and figs 3A through 3F. Several different examples are described in connection with these illustrations. In each of figs 1, 2 and 3 the drawings illustrate a step performed by the user of entering a code for a transaction or activity and then pressing "send".

6. The specification notes:

"This procedure is carried out by the user first entering a unique function code on the device's keypad to identify the type of transaction or activity desired and pressing "SEND." The mobile phone service provider's CPU identifies the desired transaction and determines if the transaction involves a default amount (as in a pre-set price for a specific highway toll plaza, transit fare, or vending machine), which is displayed on the phone's LED screen along with an "OK?" prompt." (2:34-43)

7. The action (transmission from the user's communication device to the service provider's CPU) occurs after the user's selection of the function code and specifically in response to the act of pressing "send". Those skilled in the art are aware that when a cellular communication device, such as a cell phone, is commanded to communicate in response to activation of a "send" key, communication takes place per the type of message selected for that communication.

¹ Citations are to column and line of the original patent 5,991,749.

8. While there are various procedures for message type selection (e.g. by user, by device, or by protocol or system convention), what is important across all the different kinds of devices is that there is a determination of the message type. Message type selection, preparatory to transmission includes channel selection. In other words when a message type is determined the communication device also determines whether the channel needs to be changed or not. This channel determination is a form of addressing in that by channel selection the transmission of information is addressed to device(s) or recipients (in this case the mobile service provider's CPU) which is/are configured to receive that type of message on the selected channel. Since the specification makes it clear the transmission function occurs in response to the activation of the "send" key and since those skilled in the art are aware of the message type and channel selection (i.e., addressing) and transmission occasioned by activating the "send" key, it should be apparent that those skilled in the art would immediately recognize that in this procedure there is "no further addressing", i.e. "no further addressing" beyond the channel selection, just as is claimed.

9. It is possible on other hand (when not practicing the invention), that a user may desire to transmit a message to a particular subscriber. Such an act is not any part of the present invention. In that case, however, it would be necessary for the user to identify (1) the intent to send a message to a particular subscriber and (2) to identify how to reach that subscriber, i.e., to further address the message beyond the mere act of enabling the "send" key. Neither this, nor any other form of "further addressing" is used in accordance with the invention.

10. In some examples described in the application, after sending the function identification the user may enter a telephone number (of the payee for example, see 5:36-42). This act does not affect the support already described for two reasons. In the first place, in those embodiments in which a telephone number is entered, that act occurs after the claimed function code transmission is effected and so does not affect the transmission of the function code, or its transmission "without further addressing". In the second place, entering the telephone number does not amount to further addressing since the telephone number is merely used to identify the payee, i.e., there is no addressing which employs the telephone number entered by the user.

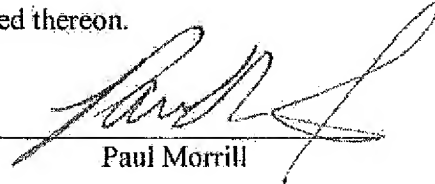
11. It should be apparent from the foregoing that the specification as filed, in effect describes that the transmission of the function code to the service provider CPU occurs in response to activation of the "send" key of the communication device "without further addressing".

12. I further declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of the application or any patent issued thereon.

Date:

1/7/10

Signature:



Paul Morrill

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SUPPLEMENTAL REISSUE APPLICATION DECLARATION BY THE INVENTOR	Docket Number (Optional) 05525-00003-US1
<p>I hereby declare that: Each inventor's residence, mailing address and citizenship are stated below next to their name. I believe the inventors named below to be the original and first inventor(s) of the subject matter which is described and claimed in patent number <u>5,991,749</u>, granted <u>November 23, 1999</u> and for which a reissue patent is sought on the invention entitled WIRELESS TELEPHONY FOR COLLECTING TOLLS, CONDUCTING FINANCIAL TRANSACTIONS, AND AUTHORIZING OTHER ACTIVITIES the application of which</p> <p><input type="checkbox"/> is attached hereto.</p> <p><input checked="" type="checkbox"/> was filed on <u>January 15, 2004</u> as reissue application number <u>10/757,724</u> and was amended on <u>July 18, 2008 and June 15, 2009</u> (If applicable)</p> <p>I have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.</p> <p><input type="checkbox"/> I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications.</p> <p>I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)</p> <p><input type="checkbox"/> by reason of a defective specification or drawing.</p> <p><input checked="" type="checkbox"/> by reason of the patentee claiming more or less than he had the right to claim in the patent.</p> <p><input type="checkbox"/> by reason of other errors.</p> <p>At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, such must be stated with an explanation as to the nature of the broadening:</p> <p>The error in the patent is a consequence of claiming less than I had a right to claim. At the time application SN 08/929,217 was filed and throughout the prosecution of that application, I was unaware that the claims then pending were unnecessarily limited to methods which included either, "expanding the function of a service provider's central processing unit to include account and authorization information," (claims 1-3 and 6-8) or "expanding the function of a service provider's central processing unit to include secure independent verification of a user's identity" (claims 4-5). The new claims 164-221 included in this application are not so limited.</p> <p>In addition, I failed to recognize and emphasize an aspect of my invention which was the utilization of information stored in the wireless device that is routinely sent to the operator of a wireless system as an identifier which can be used to access a financial account from a wireless device without the need for the user to manually enter this information. Each of the new claims 164-221 is directed to this aspect of my invention.</p>	

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Claim 164 recites:

transmitting ... along with user identification information, the user identification information comprising wireless device identification information, to a central processing unit.

Claim 170 recites:

sending the payment transaction instruction as a function code along with user identification, said user identification comprising wireless device identification information.

Claim 176 recites:

sending highway toll payment instruction information ... along with user identification information, said user identification information comprising wireless device identification information.

Claim 182 recites:

sending transit fare payment instruction information ... along with user identification information, said user identification information comprising wireless device identification information.

Claim 188 recites:

sending parking garage fee payment instruction information as a function code ... along with user identification information, said user identification information comprising wireless device identification information.

Claim 194 recites:

sending account inquiry instruction information ... along with user identification, wherein the user identification information comprises wireless device identification information.

Claim 196 recites:

receiving from the wireless device a message ... said message further including user identification, said user identification comprising wireless device identification information.

Claim 201 recites:

receiving a message from the wireless device including payment transaction instruction ... said message further including user identification, said user identification comprising wireless device identification information.

Claim 206 recites:

receiving from the wireless device a message including a highway toll payment instruction ... said message further including user identification information, said user identification information comprising wireless device identification information.

Claim 211 recites:

receiving a message from the wireless device comprising transit fare payment instruction information ... said message further including user identification information, said user identification information comprising wireless device identification information.

Claim 216 recites:

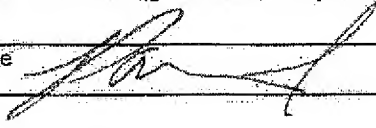
receiving a message from the wireless device comprising parking garage fee payment instruction information ... said message including user identification information, said user identification information comprising wireless device identification information.

Claim 221 recites:

receiving a message from the wireless device comprising account inquiry instruction information ... said message further including user identification information wherein the user identification information comprises wireless device identification information.

All errors being corrected in this reissue application up to the filing of this declaration arose without any deceptive intention on my part.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)		Docket Number (Optional) 05525-00003-US1	
All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.			
Note: To appoint a power of attorney, use form PTO/SB/81.			
Correspondence Address: Direct all communications about the application to:			
<input checked="" type="checkbox"/> The address associated with Customer Number:		<input type="text" value="30678"/>	
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.			
Full name of sole or first inventor (given name, family name) Paul H. Morrill, Jr.			
Inventor's signature 		Date 1/7/10	
Residence Delaware City, DE		Citizenship USA	
Mailing Address 206 Jefferson Street, Delaware City, Delaware 19706-0244			
Full name of second joint inventor (given name, family name)			
Inventor's signature		Date	
Residence		Citizenship	
Mailing Address			
<input type="checkbox"/> Additional joint inventors or legal representative(s) are named on separately numbered sheets forms PTO/SB/02A or 02LR attached hereto.			